

REMARKS

A total of 44 claims remain in the present application. The foregoing amendments are presented in response to the Office Communication mailed June 1, 2007, wherefore reconsideration of this application is requested.

By way of the above-noted amendments, Clearly, no new subject matter has been introduced.

Referring now to the text of the Office Action:

- claims 1 and 22 stand provisionally rejected under non-statutory obviousness-type double patenting over claims 1 and 13 of United States Patent Application No. 09/481924;;
- claims 2-21 and 23-33 are objected to as being dependent of a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims; and
- claims 34-44 are allowed.

Applicant appreciates the examiner's indication of allowable subject matter in claims 2-21 and 23-33, and allowance of claims 34-44. The rejection of claims 1 and 22 is believed to be traversed in view of the following.

As an initial matter, the Examiner's citation of United States Patent Application No. 09/481924 is believed to be in error. United States Patent Application No. 09/481924 issued to TRW Inc. as United States Patent No. 6,535,314 on March 18, 2003, and is directed to "Satellite optical communication beam acquisition techniques", which is clearly unrelated to the present invention. It is believed that the Examiner intended to refer to Applicant's co-pending United States Patent Application No. 10/145,035, filed May 15, 2002.

However, claims 1 and 13 of Applicant's co-pending United States Patent Application No. 10/145,035 are directed to a separate and distinct invention from claims 1 and 22 of the present application. More particularly, referring the MPEP § 806.05(j):

.... For ... related product inventions, or related process inventions, the inventions are distinct if

(A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive;

(B) the inventions *as claimed* are not obvious variants; and

(C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

It will be noted that all of the above criteria refer to the respective inventions *as claimed*, not as *disclosed* in the respective specifications. As such, the possibility that the claims of the present invention might be “disclosed in the referenced copending application”, as asserted by the examiner, is irrelevant to a consideration of double patenting.

With specific reference to criterion (A), claims 1 and 13 of the '035 application clearly do not overlap the subject matter of claims 1 and 22 of the present application. In particular, claims 1 and 13 of the '035 application recite limitations to: “a data path including an Analog-to-Digital (A/D) converter operatively coupled to a data decoder for generating a recovered data stream corresponding to subscriber digital data encoded within a respective channel signal”; and “tapping the data path between the A/D converter and the data decoder to obtain sample data generated by the A/D converter ...”. Claims 1 and 22 of the present application contain no such limitations.

Furthermore, claims 1 and 13 of the '035 application recite a limitation to: "calculating at least one performance parameter of the optical communications system based on the sample data ..." Thus it will be seen that claims 1 and 13 of the '035 application define methods and systems by which sample data is collected from a channel, and used to calculate one or more performance parameters, which will inherently pertain to the channel from which the sample data was obtained. In contrast, claims 1 and 22 of the present application explicitly define steps of obtaining and storing respective sample data for each channel of a multi-channel optical communications system, and then calculating at least one performance parameter based on the stored sample data. Since the computation of performance parameters is performed using the stored sample data (which includes respective sample data from each channel), it is possible to compute performance parameters using, for example, correlated sample data from two or more channels, taken together. The person of ordinary skill in the art will recognise that obtaining and analysing sample data from a channel; and obtaining and storing sample data from each channel of a multi-channel system, and then subsequently analysing the stored sample data, are entirely different techniques.

Accordingly, it will be seen that the respective inventions *as claimed* in the '035 application and the present invention do not overlap in scope.

With specific reference to criterion (B), the inventions *as claimed* are clearly not obvious variants. In particular, claims 1 and 13 of the '035 application recite limitations to: "a data path including an Analog-to-Digital (A/D) converter operatively coupled to a data decoder for generating a recovered data stream corresponding to subscriber digital data encoded within a respective channel signal"; and "tapping the data path between the A/D converter and the data decoder to obtain sample data generated by the A/D converter ..." In the '035 application, the location at which the data path is tapped (that is, between the A/D converter and the data decoder), means that the A/D converter output is used for both the data detection and channel monitoring. As noted at Paragraph 31 of the '035 specification, this "'dual use' of the A/D converter 16 reduces the cost and complexity of implementing the performance monitoring system 28". As noted above, claims 1 and 22 of the present application have no equivalent limitation to the location at which the channel signal is sampled. The omission of this feature

would not be obvious to a person of ordinary skill in the art, for at least the reason that doing so foregoes the benefits obtained from making “dual use” of the channel A/D converter.

With specific reference to criterion (C), the inventions *as claimed* clearly have a materially different design, mode of operation, function, or effect. In particular, the ‘035 invention *as claimed* obtains sample data from a single A/D converter, and uses this sample data to calculate at least one performance parameter, as described above. Repeating this process for each channel of a multi-channel system results in the calculation of respective performance parameters for each channel in turn. The invention defined in claims 1 and 13 of the ‘035 application system provides no means by which sample data from two or more channels, taken together, may be analysed to calculate performance parameters of the communications system. In contrast, claims 1 and 22 of the present application explicitly define steps of obtaining and storing respective sample data for each channel of a multi-channel optical communications system, and then calculating at least one performance parameter based on the stored sample data. Since the computation of performance parameters is performed using the stored sample data (which includes respective sample data from each channel), it is possible to compute performance parameters using, for example, correlated sample data from two or more channels, taken together. Thus it will be seen that the inventions *as claimed* have a materially different mode of operation, function, and effect

In light of the foregoing, it is respectfully submitted that the subject matter defined in claims 1 and 22 of the present application are clearly patentably distinct over the claimed subject matter of Applicant’s co-pending United States Patent Application No. 10/145,035. Reconsideration and withdrawal of the Provisional Double Patenting rejection, are therefore believed to be in order, and such action is courteously solicited.

It is further believed that the present application is now in good condition for allowance, and early action in this respect is courteously requested.

If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 19-5113.

Respectfully submitted,

/Kent Daniels/

By: Kent Daniels
Reg. No. 44,206
Attorney for the Applicants

Date: September 4, 2007

Ogilvy Renault
Suite 1600
1981 McGill College Avenue
Montreal, Quebec
Canada, H3A 2Y3
(613) 780 8673